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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,797	02/28/2000	HARALD WEGENER	POO,0047	6201

7590   06/16/2004

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EXAMINER
LAMB, TWYLER MARIE

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	●	Application No. 09/486,797	●	Applicant(s) WEGENER, HARALD	
		Examiner Twyler M. Lamb		Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 March 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18,20 and 21* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *10-14* is/are allowed.

6)☒ Claim(s) *1-9, 15 and 20* is/are rejected.

7)☒ Claim(s) *16-18 and 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant (s)

1.   This action is responsive to the following communications: amendment D filed on

1/22/04.

2.   This application has been reconsidered. Claims 1-18 and 20-21 are pending.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 1-2, 4-5, 15 and 20 are rejected under 35 U.S.C. 102(b) as being

anticipated by Dreyer et al. (Dreyer) (US 6,246,993).

With regard to claims 1, 15 and 20 Dreyer discloses a method for electronic

archiving (which reads on storing the completed pages on a storage medium such as an

optical disc or other storage device) (col 12, lines 49-54) of a data stream output by a

computer in a computer-specific data format (col 8, lines 47-58) that contains at least

one of graphic information and text information (col 12, lines 1-8), comprising the steps

of: distinguishing form data from variable data in the data stream (col 19, lines 50-53;

col 37, lines 55-57) based on pixels while said data is in a printer data format (col 9,

lines 30-40); and differently processing said form data in the data stream based on

pixels and variable data while the data is in the printer specific data format (which reads

on processing the master pages and the variable pages) (col 8, lines 27-34); wherein

said form data re-occurs a plurality of times in interrelated data sets (which reads on

corresponding pages of other books (col 10, lines 19-31).

With regard to claim 2, Dreyer also discloses further comprising the step of:

allocating references to the form data to the variable data (which reads on assigning file

names identifying the master page file and variable page file) (col 19, lines 50-53).

With regard to claim 4, Dreyer also discloses wherein said step of distinguishing

between form data and variable data ensues in the printer-specific data format (which

reads on converting into bitmaps usable on one or more demand printers or any other

type of display device) (col 8, lines 27-34).

With regard to claim 5, Dreyer also discloses further comprising the step of:

seeking form indicators for recognizing form data in the data stream (which reads on

assigning file names identifying the master page file and variable page file) (col 19, lines

50-56).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 3, and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Dreyer et al. (Dreyer) (US 6,246,993) in view of Tanaka (US 4,944,614).

Dreyer differs from claim 3 in that he does not clearly teach comprising the steps of: storing a form data sheet of identical form data only once within a predetermined data group storing all allocated variable data of all datasets of the data group.

Tanaka discloses a form overlay type document printing system that includes the steps of: storing a form data sheet of identical form data only once within a predetermined data group (col 2, lines 35-66) and storing all allocated variable data of all datasets of the data group (col 2, line 63 col 3, line 5).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer to include the steps of: storing a form data sheet of identical form data only once within a predetermined data group and storing all allocated variable data of all datasets of the data group as taught by Tanaka. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer by the teaching of Tanaka to ensure that the variable data will be changed upon completion of printing while maintaining the form data as is as taught by Tanaka in col 3, lines 6-12.

With regard to claim 6, Dreyer differs from claim 6 in that he does not specifically teach the steps of: investigating data of the data stream first in groups for form data, and allocating between the variable data and the form data only given repeated occurrence of form data.

Tanaka discloses a form overlay type document printing system that includes the steps of: investigating data of the data stream in groups for form data (col 2, lines 35-

44), and allocating between the variable data and the form data (col 2, lines 35-44) only given repeated occurrence of form data (col 2, lines 45-49).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer to include further comprising the steps of: investigating data of the data stream in groups for form data, and allocating between the variable data and the form data only given repeated occurrence of form data as taught by Tanaka. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer by the teaching of Tanaka to ensure that the variable data will be changed upon completion of printing while maintaining the form data as is as taught by Tanaka in col 3, lines 6-12.

With regard to claim 7, Dreyer differs from claim 7 in that he does not clearly teach the step of using overlay information as form indicators.

Tanaka discloses a form overlay type document printing system that includes further comprising the step of: using overlay information as form indicators (which reads on replacing the variable data while the form data remains as is) (col 3, lines 7-17).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer to include the step of: using overlay information as form indicators as taught by Tanaka. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer by the teaching of Tanaka to ensure that the variable data will be changed upon completion of printing while maintaining the form data as is as taught by Tanaka in col 3, lines 6-12.

With regard to claim 8, Dreyer differs from claim 8 in that he does not clearly teach the steps of: storing a form dataset after a first occurrence within the predetermined data group of the data stream; and only marking data as s form dataset, converting the data into a form bitmap and allocating the data to an appertaining variable dataset after a repeated occurrence.

Tanaka discloses a form overlay type document printing system that includes the steps of: storing a form dataset after a first occurrence within the predetermined data group of the data stream (col 2, lines 45-49); only marking data as s form dataset (which reads on discriminating form data) (col 2, lines 35-41); and converting the data into a form bitmap and allocating the data to an appertaining variable dataset after a repeated occurrence (col 3, lines 6-17).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer to include further comprising the steps of: storing a form dataset after a first occurrence within the predetermined data group of the data stream; and only marking data as s form dataset, converting the data into a form bitmap and allocating the data to an appertaining variable dataset after a repeated occurrence as taught by Tanaka. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer by the teaching of Tanaka to ensure that the variable data will be changed upon completion of printing while maintaining the form data as is as taught by Tanaka in col 3, lines 6-12.

With regard to claim 9, Dreyer differs from claim 9 in that he does not clearly teach further comprising the steps of: with a work sequence, implementing at least one of printing and archiving.

Tanaka discloses a form overlay type document printing system that includes further comprising the steps of: with a work sequence, implementing at least one of printing and archiving (which reads on maintaining the form data as is after printing) (col 3, lines 6-17).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer to include further comprising the steps of: with a work sequence, implementing at least one of printing and archiving as taught by Tanaka. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dreyer by the teaching of Tanaka to ensure that the variable data will be changed upon completion of printing while maintaining the form data as is as taught by Tanaka in col 3, lines 6-12.

Allowable Subject Matter

5.   Claims 10-14 are allowed.

6.   Claim 16-18 and 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7.   Applicant's arguments filed 1/22/04 have been fully considered but they are not

persuasive.

Applicant argues that the Dreyer reference does not disclose that there can be

several different documents in the print data stream that is being separated into fixed

and variable data and Dreyer does not teach that the fixed data can re-occur in different

documents.

Dreyer discloses the form data being used to produce corresponding pages of

other books in col 10, lines 19-31. This clearly reads on the fixed data re-occurring in

different documents.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Twyler Lamb whose telephone number is 703 - 308-

8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L Coles can be reached on 703-308-4712. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-872-9306

for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

    Commissioner of Patents and Trademarks
    Washington, DC 20231
or faxed to:

    (703) 872-9314
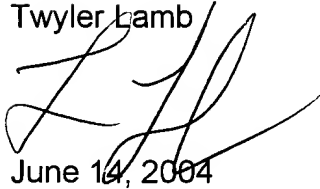   (for informal or draft communications, such as proposed amendments to be

discussed at an interview; please label such communications "PROPOSED" or
"DRAFT")
or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington. VA.

Sixth Floor (Receptionist)

Twyler Lamb

June 14, 2004